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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/862,420

05/23/2001

Mark Landesmann

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FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

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DELIVERY MODE

05/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/862,420	Applicant(s) LANDESMANN, MARK	
	Examiner Donald L. Champagne	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13, 16, 18, 19, 34, 35, 56-65, 67, 68, 70, 73, 75, 76, 91, 92, 113 and 114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9-27-01 & 1-29-02</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 9,12,14,15,17,20-33,36-55,66,69,71,72,74,77-90 and 93-112.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Denial of Priority Claim and Non-Entry of Specification Amendment

2. Applicant's request to make the instant application a continuation of US application 09758239, filed 12 January 2001, is not granted, and the specification amendment filed on 27 February 2007 is not entered. The instant application can obtain benefit of priority under 35 U.S.C. § 120 to the earlier filing date of this nonprovisional application only by complying with 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) (MPEP § 201.11).
3. In particular, the prior-filed application (09758239 in this case) must disclose at least one claim of the instant invention, said disclosure being sufficient to satisfy the requirements of 35 USC § 112, first para. (37 CFR 1.78(a)(1)). The examiner could not confirm that this requirement has been satisfied. The instant application contains similar independent claims 1 and 48, each with four limitations. The examiner could not find "a penalty deposit/ authorization" disclosed in the prior-filed application, in accordance with the second and fourth limitations of instant claim 1,

"receiving a penalty deposit of value or a penalty authorization to obtain something of value from the buyer entity to facilitate future payment of a penalty;" (claim 1, second limitation) and

"if the proof of purchase has been received within the predetermined period of time, then returning the deposit or canceling the authorization." (claim 1, fourth limitation).

4. The prior-filed application does disclose the first and third limitations of instant claim 1 (respectively at para. [0090] and [0026] of the published prior-filed application, US 20030158776A1).

Response to Claim Amendments and Arguments

5. Applicant neither made claim amendments nor provided new arguments in the filing of 27 February 2007. The previous final rejection is accordingly repeated as follows.

Warning

6. Applicant is advised that should claims 4 and 61 be found allowable, claim 6 and 63 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 7, 8, 34, 35, 56-65, 67, 68, 70, 73, 75, 76, 91, 92, 113 and 114 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 20040039639A1).
9. Walker et al. teaches (independent claims 1 and 58) a method and system for determining a serious intent to purchase a good or service, the method comprising the steps of: receiving a declaration of intent to purchase a good or service from a buyer entity and not receiving at substantially the same time a binding commitment¹ to purchase that good or service from a specific selling entity, and receiving a penalty authorization (*a payment identifier, such as a credit card ... number*) to obtain something of value from the buyer entity to facilitate future

¹ The commitment is "binding" because Walker et al. teaches a penalty, which reads on a binder. "Binding" was introduced to claim 1 by the amendment filed on 18 August 2006. The examiner could not

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payment of a penalty (para. [0010]; determining if a proof of purchase of said good or service has been received within a predetermined period of time (para. [0070-71]); if the proof of purchase has been received within the predetermined period of time, then updating a database so as to not apply a penalty ([0059] and [0072]), which reads on canceling the authorization.

10. Walker et al. also teaches claims 59, 60 and 62 ([0010]), where *the potential buyer is offered a reward* reads on providing an offer to provide at least one benefit and the offer of a reward and the reward itself are benefits respectively provided prior to and after receiving the proof of purchase; claims 61 and 63 ([0046] and [0048]), where in Fig. 5 the *Item Description* reads on "a category" and the *Item Description Rating* is the basis of the benefit/reward correlation; claims 7 and 64 ([0070]); claims 8 and 65 ([0071]); claim 67 ([0011]); claims 68 and 70 (para. [0024] and [0067], where the institution maintaining the *financial account* reads on "the third party"); claim 73 ([0055]); claim 75 ([0053]); claim 76 ([0041], where *degree of certainty 243* reads on a set of levels of intent); claims 34 and 91 ([0071], where the credit card database is the "third party database"); claims 35 and 92 ([0071], [0037] and Fig. 3, where *Potential buyer database 230*, containing a credit card account number, reads on "a source database of third party sources"); claims 56 and 113 ([0070]); and claims 57 and 114 ([0024], shares of stock).
11. Claims 2-6, 10, 11, 13, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as obvious over Walker et al. (US 20040039639A1) in view of Goldhaber et al. (US005855008A). Walker et al. does not teach (claim 2) providing the benefit without a purchase. Goldhaber et al. teaches providing the benefit without a purchase (Abstract). Because it extends the demand forecasting purpose of Walker et al. (para. 0009] and col. 4 lines 59-62 in Goldhaber et al.), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Goldhaber et al. to those of Walker et al.
12. Walker et al. also teaches claims 3 and 5 ([0010]), where *the potential buyer is offered a reward* reads on providing an offer to provide at least one benefit and the offer of a reward and the reward itself are benefits respectively provided prior to and after receiving the proof of purchase; claims 4 and 6 ([0046] and [0048]), where in Fig. 5 the *Item Description* reads

find "binding" disclosed in the published application, US 20020052752A1. Hence "binding" was not given special meaning.

on "a category" and the *Item Description Rating* is the basis of the benefit/reward correlation; claims 7 and 64 ([0070]); claim 10 ([0011]); claims 11 and 13 (para. [0024] and [0067], where the institution maintaining the *financial account* reads on "the third party"); claim 16 ([0055]); claim 18 ([0053]); and claim 19 ([0041].

Response to Arguments

13. Applicant's arguments filed on 16 May 2006 have been fully considered but they are not wholly persuasive. The rejection has been revised to address the amendments of claims 1, 2 and 57, and some rejections deleted in view of compelling argument. The examiner's reply to other arguments is as follows.
14. Applicant also argues (p. 24 *et seq.*) that the rejections given above are flawed because Walker et al. (US 20040039639A1) is not prior art. Walker et al. was filed on 18 August 2003, while the instant application has priority to at least as early as its filing date, 23 May 2001. The rejections can be valid only if Walker et al. has priority to its parent application, 09349860, filed on 8 July 1999.
15. Applicant notes correctly that continuity between Walker et al. and its parent application was not properly established at the time of filing Walker et al. Continuity was established by the assignee's successful petition to the Office to re-open the parent application. (The decision was mailed on 29 December 2005 and made of record in the instant case by IDS on 14 July 2006.)
16. However, applicant argues, "The requirement that was violated for the then-pending parent application is a statutory requirement that cannot be waived" (top of p. 25). Applicant's support for this conclusion is, first, the petition was granted after a two-year delay, based on a relaxed standard of unintentional delay. This argument is not compelling because the Office's petition examiner has the legal authority to decide such matters based on the facts, and the facts do support the decision. The assignee (Walker Digital) was made aware of the apparent lack of continuity by the examiner, who in turn was made aware by the instant applicant's learned attorney in arguments filed on 13 October 2005. Walker Digital acted promptly to perfect priority by petition, and the examiner suspended prosecution in the instant application on 19 December 2005 while the petition was being considered.

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17. As to the Walker Digital's intentions, it is credible that the error was unintentional because Walker Digital had little to gain by the error, and much to lose. Applicant argues (bottom of p. 25) that a two-year delay cannot be considered either unintentional or unavoidable, but that does not follow. The duration of the delay is irrelevant if the assignee was not aware of the break in continuity. As noted in para. 16 above, the evidence suggests that that was the case.
18. Second, applicant argues (p. 25, 2nd full para.) that the revival, even if valid, is not retroactive for patent-defeating purposes. Applicant cites *Urologix, Inc. v Prostalund AB*, 256 F.Supp2d 911 (2003) as standing for the proposition that an initial decision on abandonment may not be revisited. The examiner disagrees for two reasons. First, the case does not make such a holding, and second, even if that were the holding, the facts distinguish *Urologix* from *Walker*.
19. Holding. The holding in *Urologix* is not that an initial decision regarding abandonment may not be revisited. Applicant does not point to language to that effect in the ruling, because it is not there. To the contrary, the judge said "I can find no case addressing the retroactive effect of revival pursuant to 35 USC 41(a)(7), and the parties point to none" (256 F.Supp2d 911, 915). Rather than revisitation of abandonment, the holding is soundly placed on the judicial pillar of *stare decisis*. The court held in its April 2003 ruling that *Urologix's* patent was invalid because "the patent's invalidity has already been determined" in the October 2002 ruling (*Id.* at 915). The court further stated the October 2002 ruling could be overturned only if "clearly erroneous" (*Id.* at 914). After the October 2002 ruling, the PTO revived the abandoned *Urologix* patent, but this did not sway the court from its determination the October 2002 decision was correct at the time and could not be revisited.
20. The court even goes on to quote a Supreme Court case on the importance of the finality of a Court's judgment (quoting from *Chi. & S. Air Lines, Inc. v. Waterman SS Corp*, 333 U.S. 103 (1948), and to note that holding otherwise would allow the PTO to overrule a district court on an issue the court had specifically, previously decided.
21. Distinguished. Even if *Urologix* stood for the principle that a determination on abandonment may not be revisited, the case does not apply to *Walker*. First, in *Urologix* the determination on abandonment was made by a district court, whereas in *Walker*, the PTO made the decision. Second, *Urologix* knew since at least 1998 (in the *Technomed* litigation) of the

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- copendency problem and took no action to remedy the situation prior to the October 2002 litigation (Id. at 913). Conversely, Walker did not know of the copendency problem until advised by the examiner, and acted promptly to perfect priority (para. 16 above).
22. If Walker et al. were to become a patent, and Walker Digital brought a suit for infringement during the period of abandonment with prior knowledge of an existing problem with the patent, and a court held the patent invalid, followed by the PTO reviving the Walker parent application in order to perfect priority of the Walker patent, followed by bringing a second suit for infringement then, only then, would the logic of Urologix defeat Walker's patent. However, that is not the case here. Walker et al. has not yet become a patent, so it has not been held by a court to be invalid, and Walker Digital has not brought suit for infringement once, much less twice.
23. The priority of Walker et al. has been perfected by action of the PTO, said action being based on legitimate authority and the facts. Walker et al. is then valid prior art based on its parent filing date, and a valid basis for the rejection in this case.
24. Applicant also argues (p. 26 bottom) that Walker et al. does not disclose the making of deposits. Walker et al. does not have to because deposits are claimed in the alternative to "a penalty authorization", which Walker et al. does teach. Applicant also argues (pp. 26-27) that the intent of Walker et al. and that of the instant invention are different. The examiner believes applicant's argument makes a distinction with difference, because all merchants have sales as their intent. Also, while *claimed* differences in intent can sometimes affect patentability (MPEP § 2111.02), no difference in intent is claimed. Method and apparatus/system claims are judged primarily and respectively by their steps and structure. The references teach or suggest the claimed steps and structure.

Conclusion

25. This is a continuation of applicant's earlier Application No. 09862420. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

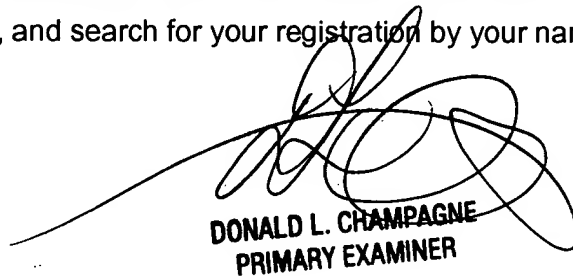
26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
28. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
30. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

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31. Applicant may have after final arguments considered and amendments entered by filing an RCE.

32. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

19 May 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622